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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/714,585

11/14/2003

Brian K. Hollowell

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/714,585	Applicant(s) HOLLOWELL ET AL.	
	Examiner SIMON SING	Art Unit 2614	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 November 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,8-10,21-25,29,30,32-34 and 37-49 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1,2,8-10,37-40,44 and 45 is/are allowed.
- 6) ☒ Claim(s) 21-25,29,30,32-34,42,43,48 and 49 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 21-25, 41, 46 and 47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tverskoy et al. US Patent No. 6,341,160 in view of Baxter, Jr. US Patent No. 6,765,996 and further in view of Skarbo et al. US Patent No. 5,778,053.

1.1 Regarding claims 21, 29 and 32, Tverskoy teaches a method of facilitating unified messaging (abstract), comprising:

communicatively coupling a messaging device (answering machine 12 in figure 1) to a premises network (PSTN) that communicatively coupled to a wide-area communication network (Internet) (fig. 1; col. 2, lines 14-47);

employing the messaging device to:

answer an incoming telephone call from a calling party (col. 3, lines 13-21);

play a pre-recorded message that prompts the calling party to leave a message for the user of the messaging device (col. 3, lines 21-25);

record a voice message from the calling party (col. 3, lines 21-29);

compose an electronic mail message in response to the voice message
(col. 4, line 62-col. 5, line 13);

attach an audio file representing the voice message to the electronic mail
(email) message; and

initiate sending of the email message via the wide-area communication
network (col. 4, lines 62-67; col. 5, lines 1-13, 24-30), and obviously, as known in
the art, to an email server associated with the user, and the email server
appends the email message to an inbox list and sending the inbox list to a user
computer.

Tverskoy does not teach including a calling party's email address in the email
message by identifying the email address based on received caller ID.

However, Baxter teaches parsing caller ID string and associating the string with a
pre-existing user record, such that the caller ID string is linked to the email address of
the caller in order for a called party to reply to an original voice message (column 2,
lines 43-55). Baxter further teaches receiving a call, recording an audio message,
attach the audio message and a caller's email address to an email, and sending the
email to a called party's email account (Abstract; col. 7, lines 13-27).

Therefore, it would have been obvious to one of ordinary skill in the art at the
time the invention was made to modify Tverskoy's reference with the teaching of Baxter,
by comparing a caller ID to lookup a calling party's email address and to include the

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calling party's email address in the outgoing electronic mail message, because enclosing the email address of the calling party would have enabled the called party to reply to the calling party by email as taught by Baxter (Abstract).

The modified Tverskoy's reference teaches audio message, but does not teach a visual message.

However, Skarbo teaches a video answering machine for recording a text message or an audio/video message from a caller (fig. 2-7; col. 4, lines 28-51; col. 6, lines 41-58).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to further modify Tverskoy's reference with teaching of Skarbo, so that a recorded message would have been a text message or an audio/video message which would have been attached to the email message as stated above. The motivation for such a modification was to substitute a known element (text/audio/video answering machine) for another (answering machine 12 in Tverskoy) to obtain predictable results.

1.2 Regarding claim 22, Tverskoy, as applied to claim 21, teaches executing code directing the computer to store a username and password in a memory associated with the messaging device, to indicate a messaging address for an intended recipient of the electronic mail message, and to indicate an identifier for a remote messaging server communicatively coupled to the wide-area network (col. 4, lines 14-23).

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1.3 Regarding claim 23, Tverskoy, as applied to claim 21, teaches determining that a data connection exists interconnecting the premises network and a node of the wide-area network; and utilizing the data connection to send the electronic mail message (col. 4, lines 14-23).

1.4 Regarding claim 24, Tverskoy, as applied to claim 21, teaches disconnecting from the incoming telephone call (col. 3, lines 29-31);

prompting a modem to dial a telephone number associated with an Internet Service Provider (col. 4, lines 14-22; col. 8, lines 24-34);

recognizing that a connection exists with the Internet Service Provider (col. 4, lines 14-22); and

utilizing the connection to send the electronic mail message (col. 5, lines 24-30).

1.5 Regarding claim 25, Tverskoy, as applied to claim 21, teaches wherein the audio file is a WAV file (col. 4, line 62-col. 5, line 13). Examiner also takes an official notice that it was well known in the art that video file a compressed, using MPEG format to reduce file size for transmission over a network.

1.6 Regarding claim 41, the modified Tverskoy reference teaches that the reply email message is automatically generated in response to the receipt of the outgoing email message and a user request as stated above (Baxter; column 3, lines 26-37).

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1.7 Regarding claims 46 and 47, examiner takes an office notice that it was well known when using MicroSoft Outlook Express, email messages in the email server are downloaded into a email client (e.g. Outlook installed in recipient's computer), and saved in a user computer to enable the recipient to view email messages off-line.

2. Claims 29, 30, 32-34, 42, 43, 48 and 49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tverskoy et al. US Patent No. 6,341,160 in view of Baxter, Jr. US Patent No. 6,765,996 and further in view of Skarbo et al. US Patent No. 5,778,053 and further in view of Friedman US Patent No. 5,826,026.

2.1 Regarding claims 29 and 32, Tverskoy teaches a method of facilitating unified messaging (abstract), comprising:

communicatively coupling a messaging device (answering machine 12 in figure 1) to a premises network (PSTN) that communicatively coupled to a wide-area communication network (Internet) (fig. 1; col. 2, lines 14-47);

employing the messaging device to:

answer an incoming telephone call from a calling party (col. 3, lines 13-21);

play a pre-recorded message that prompts the calling party to leave a message for the user of the messaging device (col. 3, lines 21-25);

record a voice message from the calling party (col. 3, lines 21-29);

compose an electronic mail message in response to the voice message
(col. 4, line 62-col. 5, line 13);

attach an audio file representing the voice message to the electronic mail
(email) message; and

initiate sending of the email message via the wide-area communication
network (col. 4, lines 62-67; col. 5, lines 1-13, 24-30), and obviously, as known in
the art, to an email server associated with the user, and the email server
appends the email message to an inbox list and sending the inbox list to a user
computer (see fig. 6 of US 6,282,565 to Shaw et al).

Tverskoy does not teach including a calling party's email address in the email
message by identifying the email address based on received caller ID.

However, Baxter teaches parsing caller ID string and associating the string with a
pre-existing user record, such that the caller ID string is linked to the email address of
the caller in order for a called party to reply to an original voice message (column 2,
lines 43-55). Baxter further teaches receiving a call, recording an audio message,
attach the audio message and a caller's email address to an email, and sending the
email to a called party's email account (Abstract; col. 7, lines 13-27).

Therefore, it would have been obvious to one of ordinary skill in the art at the
time the invention was made to modify Tverskoy's reference with the teaching of Baxter,
by comparing a caller ID to lookup a calling party's email address and to include the
calling party's email address in the outgoing electronic mail message, because

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enclosing the email address of the calling party would have enabled the called party to reply to the calling party by email as taught by Baxter (Abstract).

The modified Tverskoy's reference teaches audio message, but does not teach a visual message, and VoIP format.

However, Skarbo teaches a video answering machine for recording a text message or an audio/video message from a caller (fig. 2-7; col. 4, lines 28-51; col. 6, lines 41-58), and Friedman teaches a VOIP answering machine 702 (figure 8; col. 9, line 52 - col. 10, line 7; col. 1, lines 50-53).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to further modify Tverskoy's reference with teaching of Skarbo and Friedman, so that the messaging device would have been a VoIP capable, and a recorded message would have been a text message or an audio/video message which would have been attached to the email message as stated above. The motivation for such a modification was to substitute a known element (text/audio/video answering machine in VoIP) for another (answering machine 12 in Tverskoy) to obtain predictable results.

2.2 Regarding claim 30, Tverskoy, as applied to claim 21, teaches wherein the audio file is a WAV file (col. 4, line 62-col. 5, line 13). Examiner also takes an official notice that it was well known in the art that video file a compressed, using MPEG format to reduce file size for transmission over a network.

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2.3 Regarding claims 33 and 34, the modified Tverskoy teaches text message and video message (Skarbo) as stated above.

2.3 Regarding claims 42-43, the modified Tverskoy reference teaches that the reply email message is automatically generated in response to the receipt of the outgoing email message and a user request as stated above (Baxter; column 3, lines 26-37).

2.4 Regarding claims 48 and 49, examiner takes an office notice that it was well known when using MicroSoft Outlook Express, email messages in the email server are downloaded into a email client (e.g. Outlook installed in recipient's computer), and saved in a user computer to enable the recipient to view email messages off-line.

Allowable Subject Matter

3. Claims 1, 2, 8-10, 37-40, 44 and 45 are allowed.

The following is a statement of reasons for the indication of allowable subject matter: Applicant's amendment filed on 11/05/2010 in combination with the remarks have been reviewed, and it is agreed that the prior art of record does not teach the claimed amended limitations in the claims.

Response to Arguments

4. Applicant's arguments with respect to claims 1, 2, 8-10, 21-25, 29, 30, 32-34 and 37-49 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

5. Any inquiry concerning this communication or earlier communication from the examiner should be directed to Simon Sing whose telephone number is 571-272-7545. The examiner can normally be reached on Monday - Friday from 8:30 AM to 5:30 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang, can be reached at 571-272-7547. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-2600.

/Simon Sing/

Primary Examiner, Art Unit 2614